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Sebastien A. Jean

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEBASTIEN A. JEAN, DON FRANCIS PURPURA,
and NEIL Y. IWAMOTO

Appeal 2008-1660
Application 09/853,767
Technology Center 2400

Decided: October 29, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD,
And ST. JOHN COURTENAY III, *Administrative Patent Judges*.
THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In a paper filed on July 25, 2008, Appellants request that we rehear our decision dated May 28, 2008, wherein we sustained the rejections of all claims on appeal under 35 U.S.C. § 103. The above-noted panel only recently received this Request for decision.

We adhere to the positions, analysis, and findings set forth in our prior decision.

Our prior decision was based in part upon the analytical framework set forth with the case law noted at the middle of page 6 of our prior decision that the claimed invention does not necessarily have to be expressly suggested by any one or all of the references and, significantly, obviousness is based upon what the combined teachings of the references would have suggested to one of ordinary skill in the art. Overall, Appellants' view of Sugiura and Cooper appears to be limited to the discrete environments of use of these respective references and fails to consider the teaching value of each of them to the artisan. The Request does not address our correlations of Sugiura and Cooper to each other, and the overlapping, compatible teachings between them that we outlined in our prior decision. This compatibility analysis begins at the bottom of page 7 through our roll up analysis at the middle of page 12.

An artisan's understanding of the teachings and analysis we made with respect to Sugiura at pages 7 and 8 of our prior opinion clearly indicates that we have not overlooked and/or misapprehended any claimed feature relating to the messaging being addressed to the network address of the target device. In fact, much of the discussion during the hearing itself reflects a significant dialog on this topic. Thus, we are unpersuaded of any error in our prior decision as to this reference expressed at pages 3 and 4 of the request. Sugiura teaches or suggests to an artisan significantly much more than Appellants are willing to admit.

In like manner, Appellants view in the Request (beginning at the bottom of page 4) that we misapprehended or overlooked the significant fact that the claimed invention requires the computing device to carry out mimicking methods with respect to making a determination as to its own capability is not justified by the analysis we set forth with respect to Cooper beginning at page 8 of our prior decision. Appellants' views belittle the artisan's view of Cooper as to what this reference actually teaches or suggests. Cooper functions such that if it is determined that the functionalities are not in the printer itself, they must be passed to or redirected to the hardware service or simulation capabilities of Cooper to perform the user's desired functions in the printer. The nature of the network-based environment in Cooper's figures 1 through 3 are at least compatible and/or correlate to the nature of the subject matter in representative independent claim 1 on appeal and to Sugiura. Appellants' positions in the Request for rehearing fail to appreciate what we outlined at the bottom of page 8 of our prior decision that Cooper essentially correlates figures 1 through 3 of this reference in a manner corresponding to the subject matter of the claims on appeal and in Sugiura. Printer 118 is a network printer in figure 1 of Cooper which may receive print jobs directed toward it through a routine address such as an IP address which corresponds to the claimed network address.

Appellants' remarks at the bottom of page 5 of the request to the top of page 6 of it are based upon speculation and appear to invite us to read alleged disclosed advantages from the Specification into the subject matter of representative independent claim 1 on appeal.

Appellants wrongly interpret our statement made at the middle of page 10 of our prior decision, where we indicated our view that the actual physical location in which a determination is made was not considered pertinent or a basis of patentability since it is not recited to be in any specific module other than generally in the computing device of claim 1. This statement follows directly from our assessment in the previous paragraph bridging pages 9 and 10 of our prior decision. Moreover, what Appellants have not considered at page 6 of the request for rehearing is the subsequent sentence indicating that the teaching beginning at column 8, line 37 of Cooper actually positively teaches the splitting of the functionality of various modules between different devices. The actual logic of the determining, redirecting, and passing clause of representative independent claim 1 on appeal is essentially taught to the artisan within Cooper. This was stated in the paragraph bridging pages 10 and 11 of our prior decision.

In view of the foregoing and in closing, we have considered in detail Appellants' Request for rehearing of our prior decision, but are not persuaded by the Request to make any change therein.

Appeal 2008-1660
Application 09/853,767

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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